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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/431,843 11/02/99 ZAGON

I 98-1984

HM22/0807

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EXAMINER

LANDSMAN, R

ART UNIT

PAPER NUMBER

1647

DATE MAILED:

08/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/431,843

Applicant(s)

ZAGON ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8<sup>14-17</sup> is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims 1-8<sup>14-17</sup> are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *1. Formal Matters*

- A. The IDS, filed 6/21/00, has been entered into the record.
- B. The Notice to Comply with Sequence Rules, filed 6/21/00, has been entered into the record.
- C. The Raw Sequence Listing was entered 7/21/00.
- D. In the Office Action dated 5/19/00 the claims were restricted into 8 distinct Groups. Applicants' election with traverse of Group I, claims 1-8 and 14-17 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that that restriction is proper only in cases presenting inventions which are both independent and distinct, which is not the case in the present invention. Applicants argue that Groups I, II and III, drawn to the nucleic acid, protein and antibody are clearly related. This is not found persuasive because while these inventions are related, they are classified in different classes and/or subclasses and each requires its own divergent search. A search of one invention, for example, the nucleotide sequences would not be expected to yield art on the protein sequences or antibodies. In addition, as discussed in the original Restriction requirement (5/19/00) each of these inventions does not necessarily have to be used with each of the other inventions.

Furthermore, Applicants argue that Groups I and IV, VI and VIII as well as Groups III and V, VII are related and are, therefore, not independent. Though these inventions are related, they have been shown to be distinct, as discussed in the original Restriction requirement since the invention (i.e. product) can be used in materially different processes. See MPEP 806.05(h).

Applicants also argue that Groups I and V, VII; Groups II and IV-VIII; Groups III and IV, VI, VIII and Groups IV-VII are all different aspects of a single invention and not unrelated, or independent and distinct as the original Restriction contends and that the methods of Groups IV-VIII merely teach how to make and use the inventions of Groups I, II and III. As states in the original Restriction requirement,

Art Unit: 1647

these Groups are either unrelated, or independent and distinct as defined by MPEP 806.04, MPEP 808.01. Even if these Groups are all considered different aspects of a single invention they would still be considered products and processes of use and would be distinct as defined by MPEP 806.05.

The requirement is still deemed proper and is therefore made FINAL.

## 2. Election/Restriction

A. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I-VII. Claims 1-8 and 14-17, drawn to an isolated nucleic acid molecule, classified in class 536, subclass 23.5.

B. The inventions are distinct, each from each other because of the following reasons:

Inventions I-VII are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged. The nucleic acids, SEQ ID NO:1, 4, 5, 7, 9, 11 and 13 each encode a different opioid receptor. SEQ ID NO:1 encodes a rat receptor and SEQ ID NO:4, 5, 7, 9, 11 and 13 are splice variants of a nucleic acid encoding a human opioid receptor, as disclosed, for example, on page 12, lines 11-26.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Art Unit: 1647

C. A telephone call was made to Xiaochun on July 24, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

*Advisory information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.  
Patent Examiner  
Group 1600  
August 02, 2000

*Gary L. Kunz*  
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